

presented as to the non-applicability of the rejection for overbreadth of claims. Based on these arguments, reconsideration of the merits of this patent application is respectfully requested.

First, a suitable Terminal Disclaimer signed by an officer of Agracetus, Inc., the assignee of the present invention, is submitted herewith together with the requisite fee of \$100.00 for filing of a terminal disclaimer. This should satisfy the Examiner with regard to the issue of the obviousness-type double patenting rejection.

With regard to the rejection for claim informalities in Claims 17, 19, and 20, Claims 17 and 20 have been amended to cure the deficiency, and Claim 19 has been cancelled. These deficiencies should be cured by the changes to Claims 17 and 20.

Claims 17 - 21 and 23 are rejected on 35 U.S.C. Section 112, first paragraph, on the grounds that the disclosure is enabling only for claims limited to transformed cotton seeds and cotton plants obtained by Agrobacterium-mediated transformation. This position is the same the Examiner took in the parent application, and the applicants continue to assert that this rejection is not supported by any statutory construction and is not in accord with the applicable controlling case law.

The applicant knows of no situation in which a product which is deemed by the Examiner to be both novel and unobvious over the prior art cannot be claimed by the applicant with product claims having no process limitations. The Examiner continues to assert, apparently, that only product-by-process claims or claims in some

way limited to the process of transformation by Agrobacterium-mediated transformation are allowable to the applicant. This grounds of rejection has no statutory authority. The applicant has created a product which has been found to be both novel and non-obvious. The applicant is entitled to product claims to that product, regardless of the method of producing that product in the future.

The applicant is fully cognizant of the provisions of MPEP Sections 706.03(n) and 706.03(z). Those provisions are inapplicable here. The difference between the Examiner and the applicant does not arise from the breadth of any product limitations which should be attached to these claims. The Examiner asserts that only product claims limited by the method of manufacture are allowable. The applicant believes there is no statutory or case law authority, or support in the MPEP, for this rejection.

The provisions of MPEP § 706.03(a) require that the disclosure and the claims be corresponding. This requirement has always been met by this application and its parent. At all times, either this application or its parent has contained one or more claims similar in scope to present Claim 17. The application recites, in its second paragraph, that this invention was intended to permit genetic engineering of cotton so that the inserted genes could be inserted into useful plant varieties. Thus it has always been the intention and objective of this application to claim progeny cotton plants derived from the engineered plants.

The language of MPEP § 706.03(z) is plainly inapplicable. The MPEP section allows the Examiner to reject claims to a genus if other members of the genus are not predictable. Here applicant's specification clearly enables any genes to be inserted into cotton plants. Once it is demonstrated that one gene can be inserted, others clearly can. No unpredictability is present as to other species of this product, i.e. other genes in cotton plants. No language in MPEP § 706.03(z) says a product claim must be limited to the process by which it is made if other processes might be unpredictable. The applicant understands why this section was applied to limit the applicants' process claims. It is, however, entirely inapplicable to the Examiner's attempt to force the applicants to insert process limitations in all the product claims.

The logic behind the Examiner's position is also lacking, since such process limitation would be non-limiting in any event to the applicant's claims. In Scripps Clinic v. Genentech, Inc., 18 U.S.P.Q. 1001 (Fed. Cir. 1991), in considering product-by-process claims, the Court ruled that, "In determining patentability we construe the product as not limited by the process stated in the claims. Since claims must be construed the same way for validity and for infringement, the correct reading of product-by-process claims is that they are not limited to product prepared by the process set forth in the claims." Thus the claims in this application are, to this extent, similar in scope to those in issued Patent 5,004,863. The applicants desire to see this continuation application issue is only to have any

potential ambiguity removed. For the Examiner to object to these claims simply does not make sense, given the scope of claims of the issued patent, and filing of the Terminal Disclaimer herewith.

In an effort to carefully define the differences between the applicant and the Examiner, the applicant has proposed new Claims 24 and 25. It is believed that Claims 24 and 25 also clearly defines patentable and non-obvious subject matter. In Claim 24, it is specifically recited that there are two genes in the transgenic cotton plant, one of which codes for antibiotic resistance. As the Examiner found in the parent application of which this is a continuation, the effectivity of such a selection agent in cotton cells was nonobvious and unpredictable, given the state of the art at the time of filing the parent application. Accordingly, this product, regardless of the process made, was an unobvious one at the time of filing the parent patent application. On this basis, it is asserted that this product clearly meets the test of novelty and unobviousness. It is submitted that there is no authority for the requirement of the Examiner that process limitations be imported to a claim such as this one.

Claim 25 is submitted in the hope that it may be found in condition for allowance, even given the interpretation of Section 112, first paragraph, as expressed by the Examiner in the Office Action. The Examiner indicated that all claims, to be allowable, would have to be limited to Agrobacterium-mediated transformation. Claims 24 and 25 are different only in the

recitation of the Agrobacterium-mediated transformation limitation in Claim 25. Thus, Claims 24 and 25 are intended to point out the difference between the position of the applicant and the Examiner with clarity, in the event that an appeal in this patent application is required.

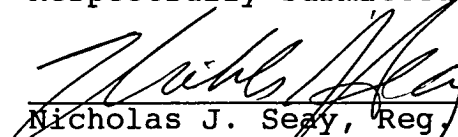
If either of these claims, or any of the remaining claims, have any wording or indefiniteness informalities under Section 112, the Examiner is encouraged to call the undersigned to see if they can be promptly corrected.

The applicant continues to believe that the Examiner's insistence that these claims be limited to the method by which the product is produced is unsupportable in view of applicable case law and statutory authority. The applicant concedes that Claims 24 and 25 do not raise new issues in the case and thus, if the Examiner is unpersuaded by applicant's argument, a final rejection may be appropriate. Nevertheless, the Examiner is requested to review the limitations of Claim 25, in the hope that at least this one claim can be found allowable. If there are other methods by which the limitation can be worded so as to satisfy the constraints of the Examiner, the undersigned would be interested in discussing them with the Examiner, so as to incorporate them in Claim 25, so as to clarify the issue if, and when, an appeal of the merits of this patent application becomes necessary.

Wherefore, based on the foregoing, an early and favorable reconsideration of the merits of this patent application is

respectfully requested.

Respectfully submitted,



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